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EXAMINER

WHITE, RODNEY BARNETT

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3636

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/500,906
Filing Date: July 02, 2004
Appellant(s): WULLUM, OLE PETTER

MAILED

AUG 04 2008

GROUP 3600

Anton E. Skaugset (#38,617)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/03/2008 appealing from the Office action mailed 10/12/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 11-18 and 20-23.

Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-10 have been canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. However, there is a new grounds for rejection for claims 13-14.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piretti (U.S. Patent No. 4,909,472).

Piretti teaches the structure substantially as claimed but is silent or does not specify that the horizontal distance between the rotational axes 11,12 is about 5-15 cm

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and 6-10 cm as defined in claims 13-14. However, it would have been obvious and well within the level of ordinary skill in the art to modify Piretti in order to make the distance between the rotational axes 11,12 either 5-15 cm or 6-10 cm as such a change in distance or size involves routine skill in the art in order to provide a comfortable distance between the seat and the chair base and depending on the size of the chair or seat in which the mobile joint is used.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,909,472

Piretti

03/1990

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16, line 6, "the desired point" lacks antecedent basis.

The aforementioned problem renders the claims vague and indefinite.

Clarification and/or correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-12, 15-18 and 20-23, so far as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Piretti (U.S. Patent No. 4,909,472)

Piretti teaches a chair comprising a mobile joint (4) for a seating construction for mounting between a seat device (1) of a seating construction and a support (5) for said seat device (1), comprising at least two joint elements (8,9) wherein each joint element is pivotable to a limited degree in relation to each joint element that it is connected to, permitting the mobile joint (4) to pivot between two extreme positions in order to allow a tilting movement of the seat device (1), effected by the user's weight displacement,

wherein the mobile joint contains a first joint element (8) mountable at a first end to the support (5) and at a second end only mounted pivotally to a first end of a middle joint element (10) at a first rotational axis (11), and further containing a second joint element (9) mountable at a first end to the seat device (1) and in the second end only mounted pivotally to a second end of the middle joint element (10) in a second rotational axis (12), wherein the said rotational axes (11,12) are horizontally displaced in relation to each other, and whereby the joint (4) assumes a stable tilting position between the two extreme positions when the user's center of gravity is above a point between the first and second rotational axes (since the user can adjust the load of the springs to obtain the desired degree of comfort), wherein the middle joint element (10) consists of a number of joint sub-elements, wherein the mobile joint (4) is configured to assume a number of additional stable tilting positions between the two extreme positions, the tilted positions of each joint element are restricted by pairs of reciprocally cooperating fitting surfaces (See Figures 3-5) where each pair of reciprocally cooperating fitting surfaces is configured to abut when a joint element is pivoted to a desired point, thereby hindering further movement of the joint element, wherein one or both members of at least one pair of cooperating fitting surfaces is equipped with a stopper (44,46) wherein the stopper is configured to dampen the impact of the pair of cooperating fitting surfaces when the corresponding joint element is pivoted to the desired point, at least two of the joint elements are spring-loaded in relation to each other, the spring-load is created by a spring coil 13a,13b,14a, the spring load is adjustable by knob 37 (See column 5, lines 14-16), the first and second joint elements have different spring-loads in relation to the

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middle joint element, the first and second joint elements have different spring-loads in relation to the middle joint element, at least two joint elements are lockable in relation to each other.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piretti (U.S. Patent No. 4,909,472).

Piretti teaches the structure substantially as claimed but is silent or does not specify that the horizontal distance between the rotational axes 11,12 is about 5-15 cm and 6-10 cm as defined in claims 13-14. However, it would have been obvious and well within the level of ordinary skill in the art to modify Piretti in order to make the distance between the rotational axes 11,12 either 5-15 cm or 6-10 cm as such a change in distance or size involves routine skill in the art in order to provide a comfortable distance between the seat and the chair base and depending on the size of the chair or seat in which the mobile joint is used.

(10) Response to Argument

Claim 1

Appellant argues:

“The joint elements of the Piretti seat construction include couplings between the first joint element and the second joint element, as well as additional couplings beyond the pivotal connections between the first joint element and the middle joint element, and the middle joint element and the second joint element. The seat construction of Piretti therefore fails to satisfy the requirements as set out in claim 11.”

It appears Appellant is arguing that Piretti has “extra” or excess structure than what is claimed or defined in claim 11. Regardless if Piretti has more parts than that of the present invention, Piretti still has the structure that meets the limitations of claim 1.

Appellant argues:

“In addition, claim 11 states that the recited joint is capable of assuming a stable tilting position between the two extreme positions when the user's center of gravity is above a point between the first and second rotational axes. The Piretti reference discloses the use of resilient means 13 and 14, in combination with various stop elements, to define the limits of travel of the Piretti. However, Piretti fails to disclose any relationship between the position of the user's center of gravity with respect to the rotational axes between joint elements and the existence of stable tilting positions. Considering the effect of resilient means 13 and 14, it is not clear that any stable tilting positions exist where the user's center of gravity is forward of horizontal axis 11, much less

that a stable tilting position exists that is between the two extremes of tilt achievable by the seat construction.

In particular, when no one is using the chair of Piretti, the resilient means (13, 14) will bias the chair to a "passive" position corresponding to the position shown in Fig. 1. When a user of the chair applies pressure on the mobile joint, it will pivot according to the movement of the user. However, due to the continuous forces applied on members (8, 9, 10) by resilient means (13, 14), the joint of Piretti can only assume a stable position under one of three conditions: First, the chair can assume a stable and "passive position" when it is not affected by the weight of the user. Second, when in a maximum forward position (based on the weight of the user, as shown in Fig. 5), such that the upper surface of the stop element (8c) of the main support member (8) abuts a rubber pad (46) carried under the front part of the seat support member: Third, when in a maximum backward position such that a rubber pad (44) carried at the rear by the lower surface of the seat support member (9) abuts a flat abutment plane (45) provided above the bushes (20) of the main Support member (8) (see col. 4, line 64 to col. 5, line 30).

In contrast; claim 11 specifically recites that the claimed mobile joint "assumes a stable tilting position between the two extreme positions when the user's center of gravity is above a point between the first and second rotational axes." As described in the specification (for example at page 6, lines 11-14), this intermediate position is defined between the axes 40 and 50. The present joint is able to assume three discrete positions: The initial position shown in Figs. 3, 6 and 11; the intermediate position shown in Figs. 4, 7 and 12; and the extreme position shown in Figs. 5, 8 and 13. This flexibility is achieved by the stepwise activation of the rotation of the joints at the first and second rotational axes 40, 50. The joint of Piretti is unable to assume such stable intermediate positions under the influence of the weight of a user, Appellant respectfully suggests that the Piretti chair is not disclosed as being capable of assuming a stable tilting position when the user's center of gravity is between the first and second rotational axes of the Piretti chair.

Furthermore, the advantageous design of the claimed mobile joint permits the joint to assume a number of additional stable tilting positions between the two extreme positions, something the joint of Piretti is incapable of due to the forces being continually applied by the resilient means (13,14) of the Piretti joint."

Piretti clearly has all of the structure as that of the present invention and if the present invention is "capable" of performing the functions as defined, then Piretti is perfectly "capable" of performing the same functions. Depending on the size and/or weight of the user sitting in the chair, the joint of Piretti is capable of assuming a stable tilting position between the two extreme positions when the user's center of gravity is above a point between the first and second rotational axes. As stated earlier, it is true that Piretti has resilient elements 13a and 14a that provides a constant bias to the seat support member towards an upwardly position. However, the specification of Piretti does disclose that the user can adjust the load of the springs to obtain a desired degree of comfort, i.e. a stable tilting position. In claim 11, Applicant never provided any structure in Claim 11 that allows the joint (1) to assume a stable tilting position between the two extreme positions. Applicant only defined "joint elements" that are pivotable with respect to one another. In claim 11, Applicant did not define any springs, tightening mechanisms, or any other parts or structures that allows a "stable tilting position". For example, two or three levers can be pivotally attached to one another by a rivet or a pin, but will those two or three levers function like Applicant says his invention does without any special parts, structures, or mechanisms? Also, in Claim 11, Applicant defines at least two joint elements (10,30) wherein each joint element is pivotable to a limited degree in relation to each joint element that it is connected to. That limitation does not

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appear to be true since "joint element 10" does not appear to pivot at all and is not shown pivoted to any degree in any of the Figures. The only parts that appear to pivot are "middle joint element 20" and "joint element 30". But most importantly, Applicant did not define any structure that allows the "joint 1" to assume a stable tilting position without any springs, tightening or locking mechanisms, or special connections between the joints. Claim 11 in the RCE filed October 2, 2007, is full of joint elements pivotally attached to one another. However, Applicant did not define any springs, spring adjustability, or locking capabilities until claims 17-22. Unfortunately, Piretti also teaches those features except for the limitation that the spring is a torsion spring as defined in claim 19 and which has been objected to be as allowable subject matter.

Claim 12

Appellant argues:

"With respect to claim 12, Appellant suggests that Piretti fails to disclose a middle joint element consisting of a number of joint sub-elements. Additionally, as Piretti fails to disclose one stable tilting position between the two extreme tilting positions, Appellant suggests Piretti necessarily fails to disclose a number of additional stable tilting positions between the two extreme positions. For at least these reasons, the mobile joint of claim 12 is additionally not anticipated by Piretti."

The language "a number of joint sub-elements" is so broad that a "sub-element" could be anything that makes up or is attached to what has been designated as the "middle joint 10" in the Piretti patent. Applicant would have to be more specific as to what those "sub-elements" are.

Claims 13-14

Appellant argues:

“With respect to claims 13 and 14, Piretti fails to disclose a horizontal distance between rotational axes of about 5-15 cm, or a horizontal distance between rotational axes of about 5-15 cm. For at least these reasons, the mobile joint of claims 13 and 14 are additionally not anticipated by Piretti.”

While it is agreed that Piretti is silent on the distance between rotational axes 11,12, it would have been obvious and well within the level of ordinary skill in the art to modify Piretti in order to make the distance between the rotational axes 11,12 either 5-15 cm or 6-10 cm as such a change in distance or size involves routine skill in the art in order to provide a comfortable distance between the seat and the chair base and depending on the size of the chair or seat in which the mobile joint is used. (See new grounds of rejection of Claims 13-14). The distance between the rotational axes lacks patentable weight since such a feature is merely a design choice dependent on the size of the chair and, more specifically, the size of the joint(s) as previously stated.

Claims 15-18 and 20-23

Appellant offers no real arguments with respect to these claims.

Additional Issues

Appellant argues:

"The Examiner has questioned whether the structure disclosed by the Appellant will allow a stable intermediate position to be achieved without a locking feature or mechanism. Appellant respectfully suggests that they have provided abundant structural information relating to exemplary mobile joints, including angles and dimensions, and have asserted that the recited mobile joint is responsive to the shifting of the user's center of gravity, and can assume any of multiple stable tilting positions depending on the posture and position of the user. See for example the detailed discussion at page 5, line 32 to page 6, line 19; and at Figs. 3, 4, and 5.

Although the mobile joint is optionally spring-loaded (see the specification at page 6, lines 20-33), for example using torsion springs (see the specification at page 7, lines 1-5), such mechanisms are not required, and are not therefore recited in claim 11.

However, this is not germane to the rejection of the claims under 35 U.S.C. § 102. Appellant's claims recite the invention in functional terms, that is the invention is defined, in part, by what it does, rather than by what it is. It has been determined that there is nothing inherently wrong with defining selected aspects of the invention in functional terms, and that functional limitations must be evaluated and considered in the context of the prior art."

Clearly, a joint requires some type of special device or mechanism to provide the ability to the joint to maintain a "stable intermediate position". As attempted in the previous example, one should clearly understand that a joint is created by two structures being pivotally connected by a hinge or a pin. That hinge or pin allows them to pivot, such as the pin that connects the blades of a pair of scissors or a hinge on a door. Without any special devices or mechanisms, the blades of the scissors simply pivot with respect to one another and the door simply pivots on its hinge. Without springs, locks, or other devices and mechanisms or special connections, the two structures simply pivot with respect to one another and no "stable intermediate positions" are possible. In claim 11 of the RCE filed October 2, 2007, which are the claims under appeal, Applicant only claims "joints" with no mention of any springs or any other devices or connections that would provide the joint(s) with the ability to achieve "stable intermediate positions". While it is not a 112/2nd issue and while it is agreed, as appellant argues, that such mechanism are not required and are not therefore recited, the Piretti patent has all of the structures as defined in claim 11, specifically the "joints"

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and their interconnection, and is perfectly capable of functioning in the same way as the present invention.

Appellant argues:

"The Examiner has asserted that the Appellant has not addressed some concerns regarding the language of the claim. Specifically, the Examiner is troubled by the reference in claim 11 to the rotational axes (40, 50) being "horizontally displaced in relation to each other" when the distance between those two axes remains constant. The Appellant suggests that the absolute distance between the two rotational axes, which the Examiner appears to be referring to, is independent of their relative displacement in the horizontal plane. Again, Appellant that this is not germane to the rejection of the claims under 35 U.S.C. § 102, and that the language of Appellant's claims should be evaluated from the point of view of one of ordinary skill in the relevant art."

It is agreed and after further review the language is now understood and has been deemed as being clear.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,
/Rodney B. White/
Primary Examiner
Art Unit 3636
July 22, 2008

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A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Conferees:

Meredith Petravick /mcp/

David Dunn /DD/

A handwritten signature in cursive script that reads "Katherine Matecki".

**APPROVED BY DIRECTOR
KATHERINE MATECKI**